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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,320	08/15/2001	May Shana'a	J6638(C)	3577

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PATENT DEPARTMENT
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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,320

Applicant(s)

SHANA'A ET AL.

Examiner

Alysia Berman

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Receipt is acknowledged of the declaration filed February 13, 2002 and the information disclosure statements filed August 15, 2001, January 7, 2002 and May 22, 2002. Claims 1-29 are pending.

Information Disclosure Statement

The information disclosure statement filed January 7, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the WO document listed is not prior art. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

The international search report has been crossed out on the information disclosure statement because it is not prior art. However, the prior art documents listed therein have been considered.

Specification

The use of the trademark Glydant Plus™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because it is unclear if Applicant intends to claim a composition or a method of making a composition. Does the system refer to the method of making the composition or the composition made? If Applicant intends to claim a method of making a composition, amendment of claim 1 to read "A method" instead of "A system" would overcome this rejection.

Claims 2-29 recite the limitation "The method". There is insufficient antecedent basis for this limitation in the claims. Is the system the method of making the composition or the composition made?

Claims 12-14 are indefinite because it is unclear what Applicant intends by a benefit agent. Neither the claims nor the specification provide an exclusive definition of the benefit agents or what they are benefiting. For example, do the benefit agents benefit the composition or the substance that the composition is applied to? The metes and bounds of the claims cannot be determined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-22 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,972,322 (322) in combination with US 5,622,692 (692).

US '322 is directed to a system for customized hair products (title). The system includes preparing a hair care composition by combining separate components that are selected by the user (abstract). The separate components include a base composition, a thickening composition (a performance agent) and, optionally, enhancing additives (a performance agent) (abstract). For components included in the performance agents, see the thickening complexes disclosed at column 4, lines 17-56, column 6, line 29 to column 7, line 2 and column 8, lines 23-42 and the enhancing additives at column 5, lines 4-24, column 7, lines 31-47 and column 9, line 14 to column 10, line 37. Each of the separate components may contain a preservative, a polyhydric alcohol or a fragrance (col. 12, lines 43-47). The separate components are combined and mixed to obtain a homogeneous mixture (col. 13, lines 52-63).

For a composition containing a solvent, a solubilizing agent and a preservative see the conditioner base disclosed at column 5, line 44 to column 6, line 8. For polyethylene glycol ethers of fatty alcohols and polysorbates as solubilizing agents see column 5, lines 60-67. For the viscosity of the base compositions within the instantly claimed viscosity ranges see column 3, lines 3-4, column 5, lines 36-37 and column 7, lines 58-59. For DMDM hydantoin and polyaminocarboxylic acid chelates (EDTA), see column 13, lines 48-58, 66-67, Examples 9, 13, 14 and Tables 16-21 at columns 17-23). At column 2, lines 34-36, US '322 teaches that the system is provided at a hair salon (a retail location). The compositions are packages in containers (col. 13, lines 31-34). US

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'322 teaches various compositions containing performance agents in varying amounts.

See column 4, lines 28-30 and column 9, line 26 to column 13, line 5. Varying the amounts of the active agents is considered equivalent to providing a plurality of intensity levels as instantly claimed (claims 11 and 14).

US '322 does not explicitly teach that the vehicles of each performance agent have at least two or three ingredients in common (claims 1 and 2), a blank composition (claims 3 and 4), a label identifying the components of the formulation (claim 6), that the fragrances contain a solvent and at least one preservative in common (claim 8), a label with a code (claim 20), a machine scannable bar code (claim 21), the volume of the container (claim 22) or the angle of the container's major axis during agitation (claims 25 and 26). It does not teach.

US '322 does teach that each of the compositions may contain the same components such as water, alcohols and preservatives. One of ordinary skill in the art would reasonably expect that using the same vehicles for each of the performance agents from each of the classes would result in similar effects and ensure compatibility of the different components.

US '692 teaches providing a customized cosmetic composition in a container having a bar code label for identifying the customized composition (col. 2, lines 63-67 and col. 4, lines 31-32 and 57-63).

It is within the skill in the art add an inert solvent or diluent to a cosmetic composition to dilute the composition in order to achieve the desired strength or level of activity of the compositions. Therefore, absent evidence of unexpected results, the

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addition of a blank composition having common ingredients with the performance agents is not considered critical. The volume of the container is not considered critical to the invention absent evidence to the contrary because it is within the skill in the art to select a container capable of holding an appropriate amount of composition. It is within the skill in the art to adjust the angle of container during agitation to achieve the desired mixing. Absent evidence of unexpected results, the angle of the major axis of the container during agitation is not considered critical to the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the compositions of US '322 using similar vehicles in a container with a bar code label as taught by US '692 with the reasonable expectation of obtaining compatibility of the separate components for specialized treatment compositions that can be identified for future use.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,972,322 (322) in combination with US 5,622,692 (692) as applied to claims 1-22 and 25-29 above, and further in view of US 4,851,062 (062).

US '322 and US '692 teach or suggest all the limitations of the claims as stated in the 35 U.S.C. 103(a) rejection above. They do not teach or suggest a container with a neck, a plug inserted in the neck and a cap (claim 23) or a container with a neck and a cap without an orifice (claim 24).

US '062 teaches a container for packaging cosmetic compositions that has a neck and a cap wherein the neck may be closed with a plug. See the abstract, column 1, lines 10-14, column 3, lines 39-41, 50-65 and column 4, lines 30-35.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the composition of the combination of US '322 with US '692 in a container with a plug and a cap as taught by US '062 expecting to provide cosmetic compositions in containers with safety closures for preventing contamination of the contents.

Unexpected Results

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, no data has been presented.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
July 29, 2002


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